

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL J. SULLIVAN

Appeal No. 2003-0540
Application No. 09/737,001

ON BRIEF

Before GARRIS, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 7,
mailed September 11, 2001) of claims 9 to 13, which are all of the claims pending in
this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to golf balls comprising multi-layer covers which have a hard inner layer and a relatively soft outer layer (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 9 to 13 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

Claims 9 to 13 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 14-32 of copending Application No. 08/714,661.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 13, mailed July 16, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed May 13, 2002) and reply brief (Paper No. 14, filed September 23, 2002) for the appellant's arguments thereagainst.

¹ Application No. 08/714,661 issued on April 9, 2002 as U.S. Patent No. 6,368,237.

OPINION

Initially we note that the issue concerning the Information Disclosure Statement filed on June 29, 2001 raised on page 14 of the brief relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Likewise, the request for interference raised on page 14 of the brief and the issue of new matter in the abstract raised on pages 4-6 of the brief do not relate to an appealable matter except to the extent that the new matter issue overlaps with the rejection of claims 9 to 13 based on the written description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, we will not review these issues.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The provisional obviousness-type double patenting rejection

Claims 9 to 13 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 14-32 of copending Application No. 08/714,661.

In the final rejection (p. 4) and the answer (p. 6), the examiner set forth his determination that claims 9 to 13 are not patentably distinct from claims 14 to 32 of copending Application No. 08/714,661.

The appellant has not specifically contested this rejection in the brief or reply brief. Since the appellant has not asserted any error that would cause this rejection of claims 9 to 13 to be in error, we summarily sustain the provisional rejection of claims 9 to 13 under the judicially created doctrine of obviousness-type double patenting over claims 14-32 of copending Application No. 08/714,661.²

The written description rejection

We sustain the rejection of claims 9 to 13 under 35 U.S.C. § 112, first paragraph.

The first paragraph of 35 U.S.C. § 112 states that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

In written description cases, " [t]he primary consideration is **factual** and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art

² Page 14 of the brief provides that the appellant is amenable to filing a terminal disclaimer in this application.

by the disclosure." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) (emphasis added). The written description requirement does not require the appellant "to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). Thus, the written description requirement of paragraph one of 35 U.S.C. § 112 ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he or she was in possession of the subject matter of the claims. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). However, claims added by a preliminary amendment to an application must find adequate support in the original disclosure of the application to meet the description requirement of 35 U.S.C. § 112, first paragraph. See In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975).

In the written description rejection before us in this appeal, the examiner determined that the following limitations did not find written description support in the original disclosure: (1) the outer layer of the cover being formed of a first ionomer resin having a Shore D hardness of 40 to 49 as recited in claims 9 and 10; and (2) the difference in hardness between the first and second ionomer resins being at least 5 in Shore D hardness as recited in claims 9 and 10. In addition, the examiner determined

that the following combination of limitations as recited in claims 9 and 10 did not find written description support in the original disclosure: (a) the outer layer of the cover being formed of a first ionomer resin having a Shore D hardness of 40 to 50 or 55 and a thickness of at least 0.4 mm; (b) the inner layer of the cover being formed of a second ionomer resin having a Shore D hardness of 57, 64 or 66 to 68 and higher than the hardness of the first ionomer resin; and (c) the difference in hardness between the first and second ionomer resins being at least 5 in Shore D hardness.

With respect to the outer layer, the original disclosure teaches (1) that the outer layer is comprised of a relatively soft, low modulus (about 1,000 psi to about 10,000 psi) and low acid (less than 16 weight percent acid) ionomer, ionomer blend or a non-ionomeric thermoplastic elastomer (p. 24); (2) that preferably, the outer layer includes a blend of a high modulus (hard) ionomer with a low modulus (soft) ionomer to form a base ionomer mixture wherein the high modulus ionomer has a Shore D hardness of at least 50 and the low modulus ionomer has a Shore D hardness of about 20 to about 40 (pp. 24-25); (3) specific disclosed hard ionomer resin examples have a Shore D hardness of 55, 57, 58, 59, 60, 61, 62, 63, 64 and 66 (pp. 27-29); (4) specific disclosed soft ionomer resin examples have a Shore D hardness of 32, 35 and 39 (pp. 31, 33 and 34); and (5) examples 28 and 29 in Table 4 of U.S. Patent No. 4,884,814 (referenced on page 34) include covers having a Shore D hardness of 53 and 45.

With respect to the inner layer, the original disclosure teaches (1) that the inner layer is comprised of a high acid (i.e. greater than 16 weight percent acid) ionomer resin or high acid ionomer blend (p. 10); and (2) specific disclosed ionomer resin examples have a Shore D hardness of 40, 42, 45, 48, 50, 57, 64, 66, 67, 68, 69, 70, 71, 72, 73, 74, 76 and 77 (pp. 13-15, 18 and 21-22).

With respect to the thickness of the outer layer, the original disclosure teaches that the outer layer is about 0.010 to about 0.050 (about 0.254 mm to about 1.270 mm) in thickness (p. 35). With respect to the difference in hardness between the first and second ionomer resins being at least 5 in Shore D hardness, the original disclosure teaches that a hard inner cover layer is molded about a core and a comparatively softer outer layer is molded over the inner layer (p. 35).

In our view, the above-noted portions of the original disclosure do provide written description support for the outer layer having a thickness of at least 0.4 mm as recited in claims 9 and 10. In that regard, a thickness of 0.4 mm for the outer layer is within the range of possible thicknesses taught by the appellant. Thus, we conclude that the appellant had possession of an outer cover thickness of at least 0.4 mm. In addition, it is our opinion that the above-noted portions of the original disclosure do provide written

description support for the difference in hardness between the first and second ionomer resins being at least 5 in Shore D hardness as recited in claims 9 and 10.

It is our opinion that the original disclosure does not provide written description support for the outer layer of the cover being formed of a first ionomer resin having a Shore D hardness of 40 to 49 as recited in claims 9 and 10. In that regard, one skilled in this art would not have envisioned the outer layer of the cover being formed of a first ionomer resin having a Shore D hardness of 40 to 49 as recited in claims 9 and 10. Moreover, the original disclosure does not provide written description support for the following combination of limitations as recited in claims 9 and 10: (a) the outer layer of the cover being formed of a first ionomer resin having a Shore D hardness of 40 to 50 or 55 and a thickness of at least 0.4 mm; (b) the inner layer of the cover being formed of a second ionomer resin having a Shore D hardness of 57, 64 or 66 to 68 and higher than the hardness of the first ionomer resin; and (c) the difference in hardness between the first and second ionomer resins being at least 5 in Shore D hardness. In that regard, one skilled in this art would not have envisioned that the appellant possessed the above-noted combination of limitations.

The case of In re Ruschig, 379 F.2d 990, 154 USPQ 118 (CCPA 1967), is instructive here. In that case, the court affirmed the holding of the Patent Office Board

of Appeals that one of the claims, adopted for purposes of interference, was not supported by the disclosure. The claim at issue in that case was directed to a single compound. The applicants argued that, although the compound itself was not disclosed, one skilled in the art would find support for the claimed compound in the general disclosure of the genus of compounds to which the claimed compound belonged. The Ruschig court rejected that argument, stating that

[i]t is an old custom in the woods to mark trails by making blaze marks on the trees. It is of no help in finding a trail or in finding one's way through the woods where the trails have disappeared—or have not yet been made, which is more like the case here—to be confronted simply by a large number of unmarked trees. We are looking for blaze marks which single out particular trees. We see none. Id. at 994-95, 154 USPQ at 122.

Although this case differs from Ruschig in that what was disclosed in Ruschig was a genus encompassing potentially half a million compounds, the rationale applies equally to this case, in which a multitude of ionomer resins and blends thereof are disclosed, with no “blaze marks” directing the skilled artisan to the claimed Shore D hardness ranges or what the difference in hardness should exceed. See id. at 994, 154 USPQ at 122 (“Specific claims to single compounds require reasonably specific supporting disclosure and while we agree with the appellants, as the board did, that naming is not essential, something more than the disclosure of a class of 1000, or 100, or even 48, compounds is required.”). As Ruschig makes clear, one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say “here is my invention.” In order to satisfy the written description requirement, the blaze marks

directing the skilled artisan to that tree must be in the originally filed disclosure. See id. at 994-95, 154 USPQ at 122; Fujikawa v. Wattanasin, 93 F.3d 1559, 1570-71, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996); Martin v. Mayer, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987) ("It is 'not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure. ... Rather, it is a question whether the application necessarily discloses that particular device.'") (quoting Jepson v. Coleman, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)). Under that standard, we conclude that nothing in the appellant's application necessarily describes the now claimed subject matter. See also In re Daniels, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

There is nothing in the written description of this application that would suggest to one skilled in the art that the claimed Shore D hardness ranges and the claimed difference in hardness was important. There is nothing in the written disclosure as originally filed directing the skilled artisan to the claimed Shore D hardness ranges and the claimed difference. What the appellant has done is to pick a hardness range supported in part by specific examples characteristic possessed by two of their formulations, a characteristic that is not discussed even in passing in the disclosure, and then make it the basis of claims that cover not just the specific examples, but any formulation that has that characteristic. This is exactly the type of overreaching the

written description requirement was designed to guard against. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) ("Adequate description of the invention guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.") (quoting Rengo Co. v. Molins Mach. Co., 657 F.2d 535, 551, 211 USPQ 303, 321(3d Cir. 1981)). See also Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 56 USPQ2d 1481, (Fed. Cir. 2000).

The appellant argues that from the specific disclosed ionomer resin examples, the skilled artisan would have been able to establish the claimed Shore D hardness limitations. In our view, the original specification does not clearly disclose to the skilled artisan that the appellant considered the now claimed Shore D hardness limitations to be part of his invention. We have reviewed the originally filed disclosure and find no express disclosure for the above-noted Shore D hardness limitations found in claims 9 and 10. In addition to an express disclosure, the written description requirement can be satisfied by showing that the disclosed subject matter, when given its "necessary and only reasonable construction," inherently (i.e., necessarily) satisfies the limitation in question. See Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988). In addition, for the reasons set forth above, there is nothing in the original application to suggest the

claimed Shore D hardness limitations as set forth in independent claims 9 and 10. In that regard, we note that a disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. See Tronzo v. Biomet Inc., 156 F.3d 1154, 1158-60, 47 USPQ2d 1829, 1832-34 (Fed. Cir. 1998); Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); Vas-Cath Inc., 935 F.2d at 1563-64, 19 USPQ2d at 1117; In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975); In re DiLeone, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971); In re Wohnsiedler, 315 F.2d 934, 937, 137 USPQ 336, 339 (CCPA 1963).

For the reasons set forth above, the decision of the examiner to reject claims 9 and 10, and claims 11 to 13 dependent thereon, under 35 U.S.C. § 112, first paragraph, is affirmed.

ADDITIONAL CONSIDERATION

In any further prosecution before the examiner, we recommend that the examiner determine if claims 9 to 13 are patentable over U.S. Patent No. 4,431,193 to Nesbitt alone or in combination with other prior art. Any rejection of claims 9 to 13 on prior art requires the Group Director's approval (see MPEP § 2307.02) since these

claims have been copied from a U.S. patent where that rejection would also be applicable to the corresponding claims of the patent.

Specifically, we recommend, in any further prosecution, the examiner determine if claims 9 to 11 and 13 are anticipated by Nesbitt. Nesbitt discloses a golf ball having a solid (not thread-wound) resilient center or core, and a multilayer cover construction which involves a first layer or ply of molded hard, high flexural modulus resinous material on the core, and a second or cover layer of soft, low flexural modulus resinous material molded over the first layer to form a finished golf ball. Nesbitt specifically teaches that the first layer (i.e., the inner layer) is of a thickness in a range of 0.020 inches and 0.070 inches and may be of resinous material such as Type 1605 Surlyn[®] marketed by E. I. du Pont de Nemours and Company, and the second or cover layer (i.e., the outer layer) is of a thickness in a range of 0.020 inches and 0.100 inches and may be of resinous material such as Type 1855 Surlyn[®] marketed by E. I. du Pont de Nemours and Company.

U.S. Patent No. 5,803,831 in discussing U.S. Pat. No. 4,431,193 teaches (column 2, lines 35-50) that type 1605 Surlyn[®] is now designated Surlyn[®] 8940 and that type 1855 Surlyn[®] is now designated Surlyn[®] 9020. U.S. Patent No. 4,884,814 teaches (column 7, table I) that Surlyn[®] 8940 has a Shore D hardness of 65 while U.S. Patent

No. 5,803,831 teaches (column 20, table 8) that Surlyn® 8940 has a Shore D hardness of 66. U.K. Patent Application No. 2 264 302 A teaches (page 5, lines 10-15) that Surlyn® 9020 has a Shore D hardness of 55.

Thus, it would appear to us that Nesbitt's first ionomer resin (i.e., Surlyn® 1855) in the outer layer has a Shore D hardness that falls within the claimed range of 40 to 50 or 55 (i.e., 55), that Nesbitt's second ionomer resin (i.e., Surlyn® 1605) in the inner layer has a Shore D hardness that falls within the claimed range of 57, 64, or 66 to 68 (i.e., 66), and that the difference in hardness between the first and second ionomer resins falls within the claimed range of at least 5 in Shore D hardness (i.e., 11). Accordingly, in any further prosecution before the examiner, we recommend that the examiner determine if claims 9 to 11 and 13 are anticipated by Nesbitt and if so obtain the Group Director's approval as required by MPEP § 2307.02.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9 to 13 under the judicially created doctrine of obviousness-type double patenting is affirmed and the decision of the examiner to reject claims 9 to 13 under 35 U.S.C. § 112, first paragraph, is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2003-0540
Application No. 09/737,001

Page 16

DIANE COVELLO, ESQ.
SPALDING SPORTS WORLDWIDE, INC.
425 MEADOW STREET
PO BOX 901
CHICOPEE, MA 01021-0901

JVN/jg